

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85898957
LAW OFFICE ASSIGNED	LAW OFFICE 111
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_21623516118-20150605131153606753_._Rec._Req._D_CARNE_85898957_.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT16\IMAGEOUT16\858\989\85898957\xml23\RFR0002.JPG
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ORIGINAL PDF FILE	evi_21623516118-20150605131153606753_._Ex._A-._Rec._Req._D_CARNE_85898957_.pdf
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ORIGINAL PDF FILE	evi_21623516118-20150605131153606753_._Drawing-_D_CARNE.pdf
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SIGNATURE SECTION	
RESPONSE SIGNATURE	/tmc/
SIGNATORY'S NAME	Tanya Marie Curcio

SIGNATORY'S POSITION	Associate Attorney, Vorys, Sater, Seymour & Pease LLP, New York Bar Member
SIGNATORY'S PHONE NUMBER	202-467-8800
DATE SIGNED	06/05/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Jun 05 13:17:02 EDT 2015
TEAS STAMP	USPTO/RFR-216.235.16.118-20150605131702886488-85898957-530a6748552e40bcd045ea2f25402be74a297bae1b79ab627788835527fdbde16-N/A-N/A-20150605131153606753

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85898957** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Original PDF file:

[evi_21623516118-20150605131153606753_. Rec. Req.- D CARNE_85898957_.pdf](#)

Converted PDF file(s) (3 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

Original PDF file:

[evi_21623516118-20150605131153606753_. Ex. A- Rec. Req.- D CARNE_85898957_.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

Original PDF file:

[evi_21623516118-20150605131153606753_. Drawing- D_CARNE.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /tmc/ Date: 06/05/2015

Signatory's Name: Tanya Marie Curcio

Signatory's Position: Associate Attorney, Vorys, Sater, Seymour & Pease LLP, New York Bar Member

Signatory's Phone Number: 202-467-8800

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85898957

Internet Transmission Date: Fri Jun 05 13:17:02 EDT 2015

TEAS Stamp: USPTO/RFR-216.235.16.118-201506051317028

86488-85898957-530a6748552e40bcd045ea2f2

5402be74a297bae1b79ab627788835527fdbde16

-N/A-N/A-20150605131153606753

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Examining Attorney: Douglas Lee

Mark: D'CARNE

Applicant: Diaz Wholesale & Mfg. Co., Inc.

App. Number: 85/898,957

Filing Date: April 9, 2013

RECONSIDERATION REQUEST AND NOTICE OF APPEAL

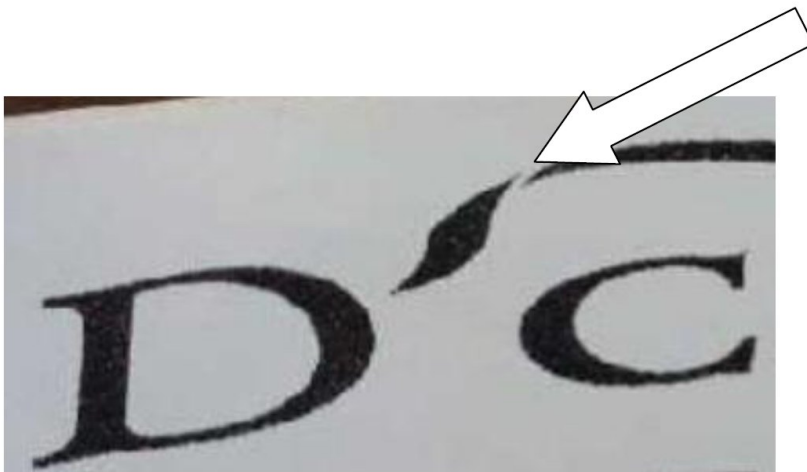
Diaz Wholesale & Mfg. Co., Inc. ("Applicant") filed a trademark application seeking to register the word mark D'CARNE for *Meat* in International Class 29. A Notice of Allowance was issued on November 26, 2013. On May 9, 2014 Applicant filed a Declaration of Use with a specimen of use. In a Non-Final Office action issued June 4, 2014, the Office refused to accept the specimen filed with the Declaration of Use because the Examiner claimed that "the specimen does not show the applied-for mark in the drawing in use in commerce." Applicant filed a response arguing that the specimen is acceptable because, 1) the mark on specimen is *substantially* an exact representation of the mark on the drawing as required by the TMEP (rather than the specimen being a "more than a minor variation" as required by the Examiner) and 2) design elements in a specimen are routinely accepted by the Office in place of punctuation in the drawing of a mark.

Despite substantial evidence to the contrary, the Examiner maintained his position and use of the improper standard of review and issued a final Office Action on December 5, 2015 stating without substantiating evidence that "it is unlikely that prospective purchasers would recognize the design as a replacement for an apostrophe."

Applicant respectfully disagrees with the Office and requests that the Examiner reconsider and withdraw the refusal of the specimen. Simultaneously with this Request for Reconsideration, Applicant has filed a Notice of Appeal.

Mark On Specimen Agrees With Mark On Drawing

Consumers are likely to perceive the design as an apostrophe because, as evidenced by the numerous examples provided by Applicant in the response to the Office Action, designs are commonly used in place of or in addition to punctuation. The Examiner has provided no evidence to contradict such or to support his conclusion that consumers would not recognize the ribbon-like apostrophe design as the apostrophe. Furthermore, the ribbon design is not a "replacement for an apostrophe" but is the apostrophe represented in a stylized manner. A clear standard apostrophe appears at the left lower end of the design, in that the design contains a break at the exact point where a standard apostrophe ends. See below. Accordingly, the ribbon like design is a *substantial* representation of the apostrophe in the mark as required by TMEP §807.12(a) and 37 C.F.R. §2.51(b). The Examiner has never explained or stated why or how the mark on the specimen is not a substantial representation of the drawing.



Additionally, Applicant's wholesale consumers would understand the ribbon like apostrophe design as the apostrophe because Applicant uses other marks with the "D'" formative and thus has a family of "D'" marks. See Registration Number 3,734,759 attached as Exhibit A.

In addressing Applicant's evidence that stylizations of marks on specimens are routinely accepted by the Office to show use of word marks the Examiner states with reference to Reg. Nos. 4,269,327 and 2,034,882 that "those registrations are for standard character marks consisting of wording only." That is part of the point Applicant is making by citing those marks. The drawings are standard character marks, just like the mark in this case, and the specimens containing drastic stylizations of the letters were acceptable. To address the remaining evidence submitted by Applicant the Examiner states "there were designs in place of punctuation in support of standard character marks." Again, that is exactly Applicant's point- designs are routinely accepted on specimens in place of punctuation of standard character marks.

Since the Examiner agrees with the Applicant's evidence that designs in place of punctuation to support use of a standard character mark are routinely acceptable and has provided no evidence that the apostrophe ribbon design is not a *substantial* representation of the apostrophe in the standard character drawing as required by the TMEP, there are no grounds for maintaining the refusal of the specimen.

Amendment to the Mark

In the alternative, Applicant requests that, in accordance with the Examiner's suggestion in the June 4, 2014 Office Action, the Mark be amended to the attached stylized mark that is an exact replica of the mark displayed in the specimen. In the event the Mark is amended accordingly, Applicant also requests that the following description of the mark be entered on the record:

The mark consists of the phrase D'CARNE with the apostrophe therein extended into a ribbon like design.

Applicant suggests the following design codes:

- 26.17.02 Wavy line(s), band(s) or bar(s)
- 09.01.04 Ribbons, bows
- 27.03.05 Representations of objects forming letters or numerals, including punctuation

Conclusion

Because the stylized mark on the specimen is a substantially exact representation of the applied-for word mark and the Office has a long history of accepting highly stylized specimens as evidence of use of a word mark, the specimen filed in this case is acceptable. Applicant respectfully requests that the Examiner withdraw the refusal of the specimen and approve the application for registration or, in the alternative, amend the mark and description of the mark as requested herein.

United States of America

United States Patent and Trademark Office

D'SABOR

Reg. No. 3,734,759 DIAZ WHOLESALE AND MANUFACTURING CO., INC. (GEORGIA CORPORATION), DBA
Registered Jan. 5, 2010 DIAZ FOODS,
5501 FULTON INDUSTRIAL BLVD.
ATLANTA, GA 30336

Int. Cl.: 29

FOR: DRIED BEANS, IN CLASS 29 (U.S. CL. 46).

**TRADEMARK
PRINCIPAL REGISTER**

FIRST USE 5-7-2008; IN COMMERCE 5-7-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 77-398,929, FILED 2-16-2008.

ANNE FARRELL, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

D'Carne